

40059-0010

10/700,714

AMENDMENTS TO THE DRAWINGS

Please substitute the enclosed replacement drawings including Figures 3, 4A, 4B, 4C, and 5 for the previous version of drawing sheets including the same figures. The replacement drawing sheets are attached hereto as Appendix A.

The replacement drawing sheets amend the drawings by adding reference number "57" to Figures 3 and 4A to identify an edge forming surface of form member 42, adding reference number "87" to Figure 4B to identify an edge forming surface of form member 72, adding reference number "107" to Figures 4C and 5 to identify an edge forming surface of form member 92, adding "deck side 66" and an arrow in Figure 4A to identify the deck side of edge forming surface 57, and adding "pool side 68" and an arrow in Figure 4A to identify the pool side of edge forming surface 57. Each of the amendments is fully supported by the original application. The specification has been amended as shown herein to coincide with these amendments to the drawings.

40059-0010

10/700,714

REMARKS

The outstanding Final Office Action: (1) disapproved of the previously proposed drawing correction filed as not be in based upon the immediate prior version; (2) objected to the drawings due to missing numerals; (3) objected to the specification as failing to provide proper antecedent basis for the claimed subject matter under 37 CFR 1.75(d)(1); (4) rejected claims 1-23 under 35 U.S.C. §112, first paragraph because the specification, while being enabling for an edge constructing apparatus clamped to a form member and wedged to a track, allegedly does not reasonably provide enablement for only a form mating portion and a track mating portion; (5) rejected claims 1, 11, 21, 22, 24-33, and 39-43 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; (6) rejected claims 1-33, 35, 36, 38, 40, 42, and 43 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,776,501 to Loftin (hereinafter referred to as "Loftin"); (7) rejected claims 1-33, 35, 36, 38, 40, 42, and 43 under 35 U.S.C. §103(a) as being unpatentable over Loftin and U.S. Patent No. 4,967,424 to Stegmeier (hereinafter referred to as "Stegmeier"); and (8) rejected claims 1-43 under 35 U.S.C. §103(a) as being unpatentable over the Applicant's admitted prior art and Loftin.

By the forgoing amendment, paragraph [0021] of the specification and claims 1, 8, 11, 12, 17, 18, and 19 have been amended. Claims 44-46 have been added and claims 2, 3, 6, 13, and 14 have been cancelled. The amendments presented herein do not introduce new matter. Support for the amendments can be found in Figs. 1-5 of the originally-filed drawings and the corresponding description of these figures in Applicant's originally-filed specification, for example.

40059-0010

10/700,714

Applicant respectfully requests entry of the amendments presented herein into the record. Many of the amendments presented herein have been presented to comply with requirements for form set forth in the Office Action. (37 CFR § 1.116(b)). Upon entry of the amendments into the record, claims 1, 4, 5, 7-12, and 15-46 will be pending with claims 1, 11, 24, and 31 being in independent form. Reconsideration of the presently pending claims is respectfully requested based on the amendments presented herein and for the following reasons.

Objections to the Drawings

On page 2 of the Office Action, the Examiner disapproved of the drawing correction filed on May 15, 2006 because Fig. 5 thereof was not based upon the immediate prior version. Applicant respectfully thanks the Examiner for providing a copy of the immediate prior version of Fig. 5. Consequently, Applicant has submitted an updated version of the drawing correction including a Fig. 5 based on the immediate prior version. Additionally, Applicant has included the missing reference numerals indicated in the outstanding Office Action, in order to remedy the objections to the drawings. For the foregoing reasons, Applicant respectfully requests that the corrected drawing sheets be entered and that the Examiner withdraw the objections to the drawings.

Objection to the Specification

The outstanding Office Action objected to the Specification as failing to provide proper antecedent basis for the claimed subject matter. In particular, the outstanding Office Action requested correction of a lack of proper antecedent basis for the term "removable coupling" set

40059-0010

10/700,714

forth in claim 1. With the present response, Applicant respectfully requests entry of the amendments to paragraph [0021], as shown above, to provide proper antecedent basis for the term "removable coupling." In light of the above-mentioned amendment, Applicant respectfully requests that the Examiner withdraw the objection to the Specification.

Rejections under 35 U.S.C. §112, First Paragraph

On pages 3 and 4 of the outstanding Office Action, claims 1-23 were rejected under 35 U.S.C. §112, first paragraph because the specification allegedly "does not reasonably provide enablement for only a form mating portion and track mating portion." Office Action p. 4, lines 2-3. Applicant respectfully traverses the rejection.

In the outstanding Office Action, no reasonable basis is provided by the Examiner for asserting that the specification does not reasonably provide enablement for only a form mating portion and track mating portion. Rather, the Examiner merely repeats his initial statement as a reason for the rejection when he states: "[t]he specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims." Office Action p. 4, lines 3-7.

The burden is initially upon the examiner to establish a reasonable basis for questioning the sufficiency of the disclosure. In re Strahilevitz, 668 F. 2d 1229, 212 USPQ 561 (CCPA 1982). As mentioned, the rejection of claims 1-23 under 35 U.S.C. §112, first paragraph made in the outstanding Office Action provides no reasonable basis for questioning the sufficiency of the disclosure, and is therefore inappropriate. Consequently, the rejection of claims 1-23 under 35 U.S.C. §112, first paragraph should be reconsidered and withdrawn.

40059-0010

10/700,714

Rejections under 35 U.S.C. §112, Second Paragraph

On pages 4-6 of the outstanding Office Action, claims 1, 11, 21, 22, 24-33, and 39-43 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claims the subject matter which applicant regards as the invention. For the following reasons, applicant respectfully traverses the rejections.

First, claims 1 and 11 are not unclear as to whether the “swimming pool” is intended to be part of the claimed combination. Regarding claims 1 and 11, the outstanding Office Action states that “claim 1 is unclear as to whether the ‘swimming pool’ is intended to be part of the claimed combination since structure of the ‘apparatus’ is defined as being connected thereto (last line), but no positive structural basis therefor has been defined. Claim 11 is similarly indefinite.” Office Action, pg. 4.

As currently presented, amended claim 1 states:

An apparatus for constructing an edging for a deck of a swimming pool having a wall and an elongated pool cover track attached to the wall of the swimming pool, comprising:
a reusable form member including an edge forming portion having an inner surface shaped to form the edging and an outer surface and a coupling portion protruding outwardly from the edge forming portion, and
a support member including a mating portion having a protrusion adapted to be removably coupled to the coupling portion of the reusable form member, and a track mating portion including a track mating feature configured to removably couple the support member to a support mating feature of the elongated pool cover track, the removable coupling of the support member to the form member being substantially pool side of the edge forming surface. (*Emphasis added*).

Similarly, independent claim 11 recites “a track mating feature configured to removably mate to an elongated pool cover track...” Contrary to the assertion in the outstanding Office Action, the last line of claim 1 does not define the ‘apparatus’ as being connected to the swimming pool. Rather, the support member is claimed as having coupling structure to

40059-0010

10/700,714

removably couple the form member to the elongated pool cover track. Further, the term "pool side" is not defining a connection to a swimming pool. Rather, the term "pool side" is a relative directional indicator as illustrated by the arrow (68) in replacement drawing 4A submitted herewith. Consequently, independent claims 1 and 11 do not claim the swimming pool as a part of the claimed apparatus to be excluded from the public by the claims.

Second, claim 11 has been amended for clarity. Specifically, claim 11 is not unclear as to the language "adapted to removably mate to the form member" when claim 11 is read in its entirety. Specifically, the outstanding Office Action states that "[c]laim 11 is unclear as to the language 'adapted to removably mate the elongated track' and 'adapted to removably mate to the form member'." Office Action, Pgs. 4 and 5. According to the outstanding Office Action, the use of the terms is not clear because the Examiner understands this language to include "elements 50, 60, and 62" of the Figures. (Office Action, pg. 4).

However, independent claim 11, as amended, recites:

An apparatus for constructing an edging for a deck of a swimming pool having a wall and an elongated pool cover track attached to the wall of the swimming pool, comprising:
a reusable form member having an edging forming surface shaped to form the edging, and
a support member having a first portion including a track mating feature configured to removably mate to an elongated pool cover track, and having a second portion including a protrusion adapted to removably mate to the form member, the removable mating of the second portion of the support member to the form member being substantially pool side of the edging forming surface.
(Emphasis added).

As clearly shown in independent claim 11, the support member includes a first portion with a mating feature to removably mate to an elongated pool cover track and a second portion including a protrusion adapted to removably mate to the form member. As illustrated in the exemplary embodiments of Figs. 3 and 4A, the support member 52 is adapted via the inclusion of

40059-0010

10/700,714

elements 51 and 53. In contrast, elements 50, 60, and 62, are respectively, portions of the reusable form member, a clamp member, and the spacer. As clearly illustrated, elements 50, 60, and 62 are not adapted portions of the support member 52, as claimed. Consequently, the metes and bounds of the language in claim 11 is readily ascertainable by reading the entirety of claim 11.

Third, claims 21 and 22 are appropriate dependent claims since they further limit independent claim 11. The outstanding Office Action rejects claims 21 and 22 under 35 U.S.C. § 112, second paragraphs for being “non-sequitur as being tailored to the embodiments of Figs. 4A and 4B where base claim 11 is tailored to the embodiment of Fig. 4C as argued at page 15 of the response.” Office Action, pg. 5.

A dependent claim is proper so long as it refers back to and further limits another claim or claims in the application. *See* MPEP § 608.01(n). Additionally, it is well known that a claim is not indefinite so long as “the meaning of the terms in the claims may be ascertainable by reference to the description.” *See* 37 C.F.R. §1.75. The outstanding Office Action demonstrates that the terms in claims 21 and 22 may be ascertainable by reference to Figs. 4A and 4B and the description. Consequently, the rejection of claims 21 and 22 under 35 U.S.C. § 112, second paragraph are inappropriate and should be reconsidered and withdrawn.

Fourth, method claims 24 and 31 are not unclear as to whether the “swimming pool” is intended to be part of the claimed combination since both claims 24 and 31 are method claims detailing a method for forming a deck edging. It is clear from the claim language that the methods of independent claims 24 and 31 are for “constructing an edging for a deck of a swimming pool.” The Examiner is invited to suggest claim language that may improve the

40059-0010

10/700,714

clarity or precision of the language used. *See* MPEP §2173.02. Otherwise, the rejection of independent claims 24 and 31 should be reconsidered and withdrawn.

Fifth, claims 24 and 31 are not ambiguous or indefinite as only reciting product/apparatus limitations in support of patentability since each recite two method steps of removably coupling a support member and a form member during the construction of a deck edging. The outstanding Office Action argues that the recited steps appear to be representative of known subject matter "as indicated by the 'black box' depictions in Figs. 6A and 6B." While it is common practice to include known subject matter as a "black box" in an apparatus drawing, Figs. 6A and 6B are each, respectively, flow charts illustrating methods of forming a deck edging. The flow charts are illustrative of the method described in the specification and do not illustrate known subject matter. It strains credibility to state that a flow chart containing a box that recites a method step is a black box depiction of known subject matter. Independent claims 24 and 31 are not ambiguous because each claim includes a number of method limitations. Withdrawal of the rejection of claims 24 and 31 under 35 U.S. C. 112, second paragraph should be reconsidered and withdrawn.

Rejections under 35 U.S.C. § 102

The outstanding Office Action rejected claims 1-33, 35, 36, 38, 40, 42, and 43 under 35 U.S.C. § 102(b) as being anticipated by Loftin. For at least the following reasons, the rejection is respectfully traversed.

40059-0010

10/700,714

As amended, independent claim 1 recites:

An apparatus for constructing an edging for a deck of a swimming pool having a wall and an elongated pool cover track attached to the wall of the swimming pool, comprising:

a reusable form member including an edge forming portion having an inner surface shaped to form the edging and an outer surface and a coupling portion protruding outwardly from the edge forming portion, and

a support member including a mating portion having a protrusion adapted to be removably coupled to the coupling portion of the reusable form member, and a track mating portion including a track mating feature configured to removably couple the support member to a support mating feature of the elongated pool cover track, the removable coupling of the support member to the form member being substantially pool side of the edge forming surface.

(Emphasis added).

As illustrated above, independent claim 1 recites a reusable form member including a coupling portion protruding outwardly from the edge forming portion and a support member having a protrusion adapted to be removably coupled to the coupling portion of the reusable form member. In contrast to the claimed element, Loftin fails to teach, disclose, or suggest a form member including a coupling portion protruding outwardly from the edge forming portion. Further, Loftin fails to teach, disclose, or suggest a mating portion including a mating feature configured to removably couple the support member to a support mating feature of an elongated pool cover track. Rather, Loftin teaches an apparatus for coping a wall, wherein the apparatus has an inward oriented coupling portion and includes vertical legs that are attached directly to the face of a pool by fasteners (52). (See Loftin, Col. 2, lines 33-41). There is no teaching, disclosure or suggestion in Loftin of the apparatus being removably coupled to an elongated pool cover track.

Even when considering the apparatus of Loftin per se, as suggested by the outstanding Office Action, there is no teaching, disclosure, or suggestion of a support member having any

40059-0010

10/700,714

coupling structure to be removably coupled to a form member and an elongated pool cover track.

The outstanding Office Action identifies structure 52 of Loftin as the track mating portion.

However, as is clearly stated in Loftin, the structures numbered 52 in the drawings are "fasteners" for attaching the vertical legs of the Loftin apparatus directly to the face of a swimming pool. *See* Loftin, col. 2, lines 38-41. It is inappropriate to re-characterize the fasteners (52) of Loftin as a support member having a track mating feature to be removably coupled to a form member and a coupling feature of an elongated pool cover track.

It is well known that "[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). *See* M.P.E.P. § 2131. As noted above, Loftin, even when the claims are considered drawn to the apparatus per se, fails to teach, suggest, or disclose all of the claim limitations of independent claim 1. Consequently, for at least the above-mentioned reasons, the outstanding Office Action has failed to make out a prime facie case of anticipation under 35 U.S.C. § 102(b), and the rejection of claim 1, and all claims that depend therefrom based on Loftin should be reconsidered and withdrawn.

Further, independent claims 11, 24, and 31, as amended, also recite similar claim limitations to those of claim 1 such that the arguments made above with respect to claim 1 are equally applicable to independent claims 11, 24, and 31. Consequently, for at least the above-mentioned reasons, the outstanding Office Action has failed to make out a prime facie case of anticipation under 35 U.S.C. § 102(b), and the rejection of claims 11, 24, and 31, as well as all claims that depend therefrom based on Loftin should be reconsidered and withdrawn.

40059-0010

10/700,714

Rejections under 35 U.S.C. § 103A. Rejection of claims 1-33, 35, 36, 38, 40, 42, and 43 under 35 U.S.C. § 103(a) as being unpatentable over Loftin and Stegmeier.

The outstanding Office Action rejected claims 1-33, 35, 36, 38, 40, 42, and 43 under 35 U.S.C. § 103(a) as being unpatentable over Loftin and Stegmeier. For at least the following reasons, the rejection is respectfully traversed.

As amended, independent claim 1 recites:

An apparatus for constructing an edging for a deck of a swimming pool having a wall and an elongated pool cover track attached to the wall of the swimming pool, comprising:

a reusable form member including an edge forming portion having an inner surface shaped to form the edging and an outer surface and a coupling portion protruding outwardly from the edge forming portion, and

a support member including a mating portion having a protrusion adapted to be removably coupled to the coupling portion of the reusable form member, and a track mating portion including a track mating feature configured to removably couple the support member to a support mating feature of the elongated pool cover track, the removable coupling of the support member to the form member being substantially pool side of the edge forming surface.

(Emphasis Added).

As mentioned previously, independent claims 1, 11, 24, and 31 substantially recite a support member that is adapted or includes coupling structure, such as a track mating feature, configured to removably couple a form member and an elongated pool cover track. Further, as mentioned previously, Loftin fails to teach, disclose, or suggest a support member having structure to be removably coupled to a form member and an elongated pool cover track. In fact, the outstanding Office Action admits that “the Loftin edging constructing apparatus does not include a track and associated mating portion.” (Office Action, pg. 6). In order to overcome this shortcoming of the Loftin reference, the outstanding Office Action looks to the Stegmeier

40059-0010

10/700,714

reference as "having a cover track 44 and associated mating portion 34,46." Office Action, pg. 8.

However, in contrast to the assertions made in the outstanding Office Action, Stegmeier fails to remedy the shortcomings of the Loftin reference. Specifically, Stegmeier fails to teach or disclose a separate support member having coupling structure to be removably coupled to the form member and adapted to removably couple the form member to an elongated pool cover track. Rather, Stegmeier discloses a one-piece edging form that may be coupled to a pool cover track. Combining the track mating portion from the single one-piece edging construct of Stegmeier with the Loftin reference would constitute the use of hindsight to reconstruct the claimed elements.

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." See, e.g. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-33, 35, 36, 38, 40, 42, and 43 under 35 U.S.C. § 103(a) as being unpatentable over Loftin and Stegmeier.

Additionally, the combination of Loftin with Stegmeier to reject claims 1-33, 35, 36, 38, 40, 42, and 43 under 35 U.S.C. § 103(a) is improper. Specifically, there is no motivation to combine Loftin and Stegmeier to produce the claimed invention. While Loftin teaches a two-piece apparatus for coping a wall including a dual section form that is releasably attached to the wall adjacent its upper most surface, Stegmeier specifically teaches a single form board including retention clips. Loftin does not teach, disclose, or suggest a pool configuration with a pool cover track. Therefore, it would be inappropriate to combine Loftin, a disclosure that makes no

40059-0010

10/700,714

mention of a track with Stegmeier, a reference that deals specifically with a pool cover track.

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1420 (Fed. Cir. 1990)." M.P.E.P. § 2143.01. Consequently, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1, 4, 5, 7-12, and 15-33, 35, 36, 38, 40, 42, and 43 under 35 U.S.C. § 103(a) as being unpatentable over Loftin and Stegmeier.

B. Rejection of claims 1-43 under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Admitted Prior Art and Loftin.

The outstanding Office Action rejected claims 1-43 under 35 U.S.C. § 103(a) as being unpatentable over Applicant's admitted prior art and Loftin. For at least the following reasons, the rejection is respectfully traversed.

As amended, independent claim 1 recites:

An apparatus for constructing an edging for a deck of a swimming pool having a wall and an elongated pool cover track attached to the wall of the swimming pool, comprising:

a reusable form member including an edge forming portion having an inner surface shaped to form the edging and an outer surface and a coupling portion protruding outwardly from the edge forming portion, and

a support member including a mating portion having a protrusion adapted to be removably coupled to the coupling portion of the reusable form member, and a track mating portion including a track mating feature configured to removably couple the support member to a support mating feature of the elongated pool cover track, the removable coupling of the support member to the form member being substantially pool side of the edge forming surface.

40059-0010

10/700,714

In making the above-mentioned rejection, the outstanding Office Action points to "the Loftin reference which discloses an analogous apparatus which further includes a form member 26, 44 having two separate portions 24, 48 and 46 removably coupled by a clamp 50." However, in contrast to the assertion by the outstanding Office Action, the clamp 50 illustrated in Loftin is *not adapted to* "removably couple" a support member with a form member. Rather, the clamp 50, illustrated in Loftin removably couples two portions of the support member. (See Loftin Col. 2, lines 33-41). Consequently, the combination of Loftin with the admitted prior art fails to teach or suggest every element of independent claims 1, 11, 24, and 31.

It is well known that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, in light of the above argument, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1, 4, 5, 7-12, and 15-43 under 35 U.S.C. § 103(a) as being unpatentable over Applicant's admitted prior art and Loftin.

40059-0010

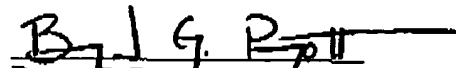
10/700,714

CONCLUSION

For the foregoing reasons, the present application is thought to be in condition for allowance. Accordingly, favorable reconsideration of the application in light of the amendments and remarks provided above is courteously solicited. If any fees are owed in connection with this paper, which fees have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

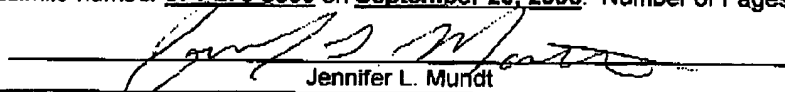
Respectfully submitted,

DATE: September 20, 2006


Bryan G. Pratt
Registration No. 48,873

Bryan G. Pratt
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095

(801) 572-0185
(801) 572-7666 (fax)

<p align="center">CERTIFICATE OF TRANSMISSION</p> <p>I hereby certify that this correspondence is being transmitted to the Patent and Trademark Office facsimile number <u>571-273-8300</u> on <u>September 20, 2006</u>. Number of Pages: <u>36</u></p> <p align="center"> Jennifer L. Mundt</p>
--